

Attorney Docket No.: 97.37US-RCE

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shah

Serial No.: 09/248,524

Group Art Unit: 1617

Filed: February 9, 1999

Examiner: Wells, Lauren Q.

For: Long-Wearing Cosmetic Compositions

**REMARKS**

The Examiner rejects Claims 1 to 15, 17, and 19 to 22 over Valdes et al. (U.S. Patent No. 4,761,277, "the '277 reference") in view of Alwattari et al. (U.S. Patent No. 5,874,072, "the '072 reference"). Specifically, the Examiner asserts that a water insoluble polymer of the '072 reference can be added to the '277 reference because of the teaching in the '072 reference that the addition of water insoluble polymer, such as ammonium acrylate, to water soluble film-forming polymers such as those found in the '277 reference results in compositions having superior wear and that are removable with soap and water. Thus, the Examiner has responded to Applicants' previous argument by shifting the assertion of interchanging the '277 water-soluble polymers and the '072 water-insoluble polymers to adding the '072 water-insoluble polymers to the '277 water-soluble polymers. In either case, there is no teaching, suggestion nor motivation to make the combination asserted by the Examiner. Regardless of whether the '072 water-insoluble polymer is interchanged with the '277 water-soluble polymer or added to the '277 water-soluble polymer, the presence of the '072 water-insoluble polymer in the '277 waterbased compositions is neither taught nor suggested by the cited references. Therefore, the cited references each alone and in combination with one another fail to render the present invention obvious.

The present invention relates, as amended, to compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment in a substantially aqueous medium. Applicants have amended Claims 1, 10, 19, and 22. Support for this amendment is found in the present specification at page 3, lines 3 to 5. The compositions of the present invention include any aqueous base or, in other words, any base that is miscible in water. The medium of the present invention is substantially aqueous and contains a combination of the water-soluble organic pigment with the polymeric component, for example, an acrylic copolymer like that of the water-insoluble polymer described in the '072 reference.

The '072 reference teaches ammonium acrylate at column 2, lines 61 to 66 in a section entitled "A. Water-insoluble Polymeric Materials." In this section, the '072 reference teaches that the water-insoluble polymeric materials are added to an emulsion mascara. Presumably, the water-insoluble polymer is added to

an emulsion because it contains at least one compatible phase (i.e., the oil phase). One of ordinary skill in the art would expect the water-insoluble polymers to be compatible with the oil phase of the '072 emulsion mascara. Thus, as the '072 reference fails to teach or suggest that water-insoluble polymeric materials are added to anything else but emulsion mascara compositions, the '072 reference fails to disclose the present invention of a composition containing a water-insoluble polymer in a substantially aqueous medium. In the absence of some teaching, suggestion, or motivation to combine the references, an obviousness rejection cannot depend on a combination of prior art references. *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186, 1193 (CAFC 2003) (*citing In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276 (Fed. Cir. 1987)). The '072 reference, further, fails to teach or suggest the present invention alone or in combination with the '277 reference because neither reference teaches or suggests the incorporation of a water-insoluble polymer in a waterbased composition.

There is no teaching or suggestion in either of the cited references to add a water-insoluble polymer used in an emulsion system (i.e., in the presence of an oil phase) to a waterbased (i.e., in the absence of an oil phase) composition. One of ordinary skill in the art would expect water-insoluble polymers to be compatible with oil and incompatible with water. This expectation is further supported by both the teachings of the '072 reference and the '277 reference. First, the water-insoluble materials of the '072 reference are present in emulsion mascara compositions as mentioned above, and as further demonstrated in the processing directions of the '072 reference where the addition of water-insoluble materials to emulsion systems having an oil phase and a water phase is taught. Further still, in each example of the '072 reference, regardless of the type of emulsion system (i.e., water-in-oil or oil-in-water,) the water-insoluble materials are added to an emulsion system having an oil phase compatible with the water-insoluble polymeric material. (See examples Processing Directions 1. and 2. at column 7, and Examples 1., 2., and 3. at columns 7 and 8.) Thus, there is no teaching or suggestion in the '072 reference to add the water-insoluble materials to a waterbased composition in the absence of an oil phase like the compositions of the '277 reference.

Clearly in contrast to the '072 reference, the compositions of the '277 reference are waterbased and do not contain an oil phase. The absence of an oil phase in the '277 compositions is significant because the '277 compositions, therefore, do not contain a phase compatible with the '072 water-insoluble polymer. Therefore, due to the differences between the '072 and the '277 compositions, one of ordinary skill in the art would not expect reasonable success taking water-insoluble polymeric materials taught in the '072 mascara emulsions and adding them to the '277 waterbased compositions (either to interchange the two types of

polymer or to add the two types of polymers together). It is well known that water-insoluble polymers are compatible with oil and incompatible with water, and thus, one of ordinary skill in the art would not find any motivation to make such a substitution or addition based on either of the cited references or in the general knowledge of the art.

Similar to the '072 reference, there is no teaching or suggestion in the '277 reference that a water-insoluble polymer can be added to the '277 waterbased compositions. While the '072 reference fairly teaches that the water-insoluble polymer works in the presence of an oil phase, it is devoid of any mention of how or if the same water-insoluble polymer could work in a waterbased composition. Conversely, while the '277 compositions are waterbased, there is no teaching or suggestion that a water-insoluble polymer can be added to them for any effect. It simply defies logical reasoning to add a water-insoluble polymer to a waterbased composition, and thus, one of ordinary skill in the art would not based on general knowledge nor the cited references make the combination suggested by the Examiner. One of ordinary skill in the art would have no reason to expect the water-insoluble polymer to work similarly, or at all, in a waterbased composition as there is no oil present. Therefore, a *prima facie* case of obviousness has not been made in the present case because one of ordinary skill in the art would not take the water-insoluble polymer of the '072 mascara emulsions and add it to the '277 waterbased compositions.

Finally, the Examiner cites Burdzy (U.S. Patent No. 5,518,728, "the '728 reference") for the premise that eyeliners and lipliners are interchangeable cosmetic product types, at column 10, lines 58 to 65. Essentially at the section cited by the Examiner, as previously mentioned in Applicants response of November 24, 2003, the authors recite a number of different forms of cosmetics that the alleged invention can take. The compositions of the '728 reference contain surface treated talc. There is no indication that any of the forms are intended to be interchangeable if they include water-insoluble acrylates copolymers. All that is noted is that the alleged invention (containing talc) can be made in any of the mentioned forms. Further, the '728 reference fails to remedy the defect in the combination of the '277 and the '072 references, namely that there is no teaching, suggestion nor motivation to add water-insoluble polymers to waterbased compositions.

The present invention makes the unexpected combination and Applicants have found that the resulting composition has long wearing properties which is surprising considering that the acrylic acid copolymer (the water-insoluble polymer of the '072 reference) is present in a predominantly aqueous medium. The present invention relates, as amended, to compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment in a substantially aqueous medium. The combination of the present invention is not even contemplated by the cited references. Thus, these surprising benefits are not recognized by the cited prior art, and therefore, the claims of the present invention are not obvious and are patentable. If a *prima facie*

case of obviousness can be made, it can be rebutted by showing "unexpected results," i.e., by showing that the claimed invention exhibits an advantage that one of ordinary skill in the art would have found unexpected, because that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious. *In re Soni*, 34 USPQ2d 1684, 1687 (CAFC 1995). Therefore, even if a *prima facie* case of obviousness in the present case can be made it can be rebutted. Accordingly, the claims are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

Date June 14, 2004



Dorene M. Price, Reg. No. 43,018  
Estee Lauder Companies  
125 Pinelawn Road  
Melville, NY 11747  
(631) 531-1194